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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,945	07/12/2001	Francis X. Ignatious	00537-184002	5355

7590

06/24/2003

Biomeasure Incorporated  
27 Maple Street  
Milford, MA 01757

EXAMINER

BENNETT, RACHEL M

ART UNIT

PAPER NUMBER

1615

DATE MAILED: 06/24/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/830,945

Applicant(s)

IGNATIOUS, FRANCIS X.

Examiner

Rachel M. Bennett

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 4-8, 11-15 and 18-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☒ Claim(s) 9, 10, 16 and 17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6, 8, 4 6) ☐ Other:

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## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse Group I drawn to a polymer and the species of polyester in Paper No. 9 is acknowledged. The traversal is on the ground(s) that there is a special technical feature comprising "a polymer bearing a thermodynamically stable lactone ring considered to be non-polymerizable". This is not found persuasive because the prior art teaches polymers that bear a non-polymerizable lactone ring. Therefore, claims 1-3, 9-10, 16-17 will be examined, which are drawn to the species, polyester.

The requirement is still deemed proper and is therefore made FINAL.

### ***Specification***

#### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Isozaki et al. (EP 0440108 A2).

Applicants disclose a biodegradable polymer comprising a non-polymerizable lactone ring, biodegradable compositions comprising the polymer and a therapeutic agent, and the use of the compositions for sustained release of therapeutic agents.

Isozaki discloses a method for curing a resin starting from a straight-chain resin containing a lactone ring. See abstract. Another method to introduce the lactone structure into

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the resin substrate is that a polymerizable unsaturated monomer containing a lactone structure are monomers disclosed in page 6, lines 37-54. The other monomer copolymerizable with these monomers is the polymerizable unsaturated monomer (the vinyl monomer or the acrylic monomer) used in forming the vinyl resin or the acrylic resin. It is the acrylic moiety which under (co-) polymerization while the lactone ring present in the monomeric compound can be considered as being non-polymerizable. Hence, it is the uncured starting material which represents a polymer to which a non-polymerizable lactone ring is attached wherein the polymer may be a polyester resin. See page 6, lines 8-11 and Example 4. Therefore, these claims are anticipated.

#### *Allowable Subject Matter*

4. Claims 9-10, 16-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### *Correspondence*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel M. Bennett whose telephone number is (703) 308-8779. The examiner can normally be reached on Monday through Friday, 8:00 A.M. to 4:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (703) 308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3592 for regular communications and (703) 308-7924 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

rmb

June 20, 2003

  
THOMAS K. PAGE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600